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PATENT & TRADEMARK OFFICE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **SUGIYAMA, Kazuhiko, et al.**

Attention: Office of Petitions

Serial No.: **10/506,671**

Group Art Unit: **3679**

Filed: **April 7, 2005**

Examiner: **KEE, Fannie C.**

For: **PIPE JOINT**

P.T.O. Confirmation No.: 5308

PETITION FOR RETURN OF FORM PTO-1449 FILED ON DECEMBER 29, 2004, PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: October 9, 2008

Dear Sir:

Applicants hereby petition to receive a copy of the Form PTO-1449 filed on December 29, 2004, marked to indicate that all references listed therein have been considered.

* * * *

STATEMENT OF FACTS:

Applicants filed an Information Disclosure Statement at the U.S. Patent and Trademark Office (the Office) on December 29, 2004.

Applicants have enclosed the following documents: (1) a copy of the Information Disclosure Statement filed December 29, 2004; and (2) a copy of the postcard receipt stamped with the date December 29, 2004.

The Information Disclosure Statement filed December 29, 2004 included a Form PTO-1449 that listed at least the following document: Item **AL**: International Search Report dated July 8, 2003.

The Information Disclosure Statement filed on December 29, 2004 complied with all the requirements of 37 C.F.R. § 1.97 and 37 C.F.R. § 1.98. Thus, the Examiner has an obligation to consider all references listed therein.

The Examiner has an obligation to consider all references, including Item **AL**. However, the Examiner placed a line through Item **AL**, even though a legible copy of the corresponding document was enclosed, and even though the corresponding document was in the English language.

That is, the Examiner placed a line through the International Search Report dated July 8, 2003 (Item **AL**), even though a legible copy of the search report was enclosed, and even though the search report was in the English language.

The Examiner, Ms. Fannie Kee, was reached by telephone on October 3, 2008. During the telephone interview on October 3, 2008, Examiner Kee did not resolve the Applicants' concerns regarding the lining-through of Item **AL**. Examiner Kee suggested that the lining-through of Item **AL** was proper. Examiner Kee suggested that search reports should not be listed on the Form PTO-1449, because search reports do not belong there.

Examiner Kee refused to provide Applicants with a copy of the Form PTO-1449 which accompanied the Information Disclosure Statement filed on December 29, 2004, marked to indicate that Item **AL** listed therein has been considered by the Office. During the interview, no agreement was reached regarding the lining-through of Item **AL**.

* * * *

REMARKS:

Applicants respectfully submit that the lining-through of Item **AL** was improper, for the following reasons.

Applicants respectfully submit that it was an error of the Office. Applicants respectfully request that the error of the Office be corrected by the Office now.

During the telephone interview on October 3, 2008, Examiner Kee took the position that search reports should not be listed on the Form PTO-1449, because search reports do not belong there.

The Manual of Patent Examining Procedure (MPEP) provides guidelines that do not support the Examiner's position. For example, MPEP § 609 states "There is no requirement that the information must be prior art references in order to be considered by the examiner."

The first Office action on the merits was mailed March 8, 2007. "An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods: ... (3) Before the mailing of a first Office action on the merits." 37 C.F.R. § 1.97(b)(3).

Therefore, the Information Disclosure Statement filed on December 29, 2004 was filed before the first Office Action on the merits. Accordingly, the Information Disclosure Statement filed December 29, 2004 should have been considered by the Office.

37 C.F.R. § 1.98(a) states "Any information disclosure statement filed under 37 C.F.R. 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3)."

In compliance with 37 C.F.R. § 1.98(a)(1), the Information Disclosure Statement filed on December 29, 2004 listed documents for consideration by the Office, including at least: Item **AL**: International Search Report dated July 8, 2003.

In compliance with 37 C.F.R. § 1.98(a)(2), a legible copy of Item **AL** was included.

In compliance with 37 C.F.R. § 1.98(a)(3), Item **AL** is in the English language, and thus no translation or concise explanation of the relevance is needed. 37 C.F.R. § 1.98(a)(3)(i) states "A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separated from applicant's specification or incorporated therein" (emphasis added).

MPEP § 609 states "Once the minimum requirements of 37 C.F.R. § 1.97 and 37 C.F.R. § 1.98 are met, the examiner has an obligation to consider the information."

MPEP § 609 states "There is no requirement that the information must be prior art references in order to be considered by the examiner."

MPEP § 609 states "The initials of the examiner placed adjacent to the citations on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner."

Applicants respectfully submit that it was improper for the Examiner to place a line through Item **AL**. Applicants respectfully submit that it was an error of the Office. Applicants respectfully request that this error of the Office be corrected now.

It is therefore respectfully requested that the Office return the copy of the Form PTO-1449 which accompanies the Information Disclosure Statement filed December 29, 2004, marked to indicate that all references listed therein have been considered by the Office.

* * * *

RELIEF REQUESTED:

Applicants therefore respectfully request the following relief.

1. Applicants request that the Office return a copy of the Form PTO-1449 which accompanied the Information Disclosure Statement filed December 29, 2004, marked to indicate that all references listed therein have been considered by the Office.

2. Applicants request all other relief as justice may require.

* * * *

It is believed that no fee is due with respect to this petition. However, if any fees are due now or in the future in connection with this petition, please charge our Deposit Account No. 01-2340. If any fees are due now or in the future in connection with this application, please charge our Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosures: Copy of Information Disclosure Statement filed December 29, 2004
Copy of date stamped postcard receipt



CARD NO: 12533

U.S. Patent Application Docket No: 040478
Serial No: 10/506,671 Filed: 09/16/04
Patent Number: Issued:
Applicant(s): SUGIYAMA, Kazuhiko, et al.

Papers filed herewith on: 12/29/04

Other: INFORMATION DISCLOSURE STATEMENT; W/PTO-1449 (10 REFS) & EUROPEAN SEARCH REPORT DATED 7/8/03.



COMMISSIONER OF PATENTS

Receipt is hereby acknowledged of the papers filed as indicated in connection with the above-identified case.

MRQ/LRJ